

In re Patent Application of  
**Gerald A. Pierson**  
Serial No. 09/938,288  
Filed August 23, 2001

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### **REMARKS**

Applicant appreciates the Examiner's careful review of the application and herein responds to the outstanding Office action.

#### **Independent Claim 35 Is Novel Over The Cited Reference**

The Examiner has rejected independent claim 35 under 35 USC §102(e) as anticipated by Smith et al. (US Patent No. 5,579,296). Applicants respectfully disagree for the following reasons.

Claim 35 recites "at least one plastic layer having a major elevational portion and a minor elevational portion, the major elevational portion having the encoded digital data thereon and the minor elevational portion being devoid of the encoded digital data." Such a layer is not described or shown by Smith et al.

The Examiner refers to Smith et al. FIG. 5, and specifically to reference numbers 10 and 30 in that figure. Applicants point out that reference numbers 10 and 30 are not one layer, but two layers, as acknowledged by the Examiner, so that Smith et al. do not describe "at least *one* plastic layer having a major elevational portion and a minor elevational portion." Smith et al. cannot, therefore, anticipate the invention recited in claim 35 and Applicants respectfully request the rejection under Section 102 be withdrawn.

Applicants believe the Examiner has inadvertently misinterpreted the "at least one layer" language in claim 35 and believes that the major and minor elevational portions may be on separate layers. Rather, as Applicants point out above, the at least one layer includes both major and minor elevational portions. See originally filed application at page 5, lines 23-25; or published application at paragraph 11. Accordingly, Applicants have amended the language of claim 35, not so as to overcome the rejection, but so that it more clearly indicates that the single layer includes both major and minor elevational portions.

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**The Claims Are Nonobvious Over The Cited Reference**

The Examiner has also rejected pending independent claims 35 and 42 as unpatentable under 35 USC 103(a) as obvious in view of the reference to Smith et al., noted previously.

The Examiner has pointed out that the Smith et al. reference "is being interpreted as disclosing a major elevational portion in the shape of the trading card, such being placed on an adaptor, the surface of which constitutes the minor elevational portion." Applicants point out that Smith et al. do not use the term "elevational portion", and even if this interpretation of the Smith et al. reference were correct, such an "elevational portion" is not what is described or claimed in the present invention.

The term "elevational portion" in the present invention, as recited in claim 35, describes a plastic layer having both major and minor elevational portions. As shown in Applicants' FIGS. 2A, 2B, 4, and 5, reference numbers 22 and 22' indicate this plastic layer having both major and minor elevational portions. The term "elevational portion" as used in the present application, therefore, indicates structural features which differ from those noted by the Examiner in the Smith et al. reference. That is, an "elevational portion" indicates the relative height of the plastic layer in a side elevation view of the disk, not the thickness of the individual plastic layer. In these figures, for example, the major elevational portion is indicated by reference number 22, and the minor elevational portion is indicated by the reference number 23. See also the originally filed application at page 11, lines 18-20; and in the published application at paragraph 34. The reference by Smith et al. neither describes nor suggests no such layer having both a major elevational portion and a minor elevational portion. Accordingly, the reference by Smith et al. would not guide the skilled to the invention recited in claim 35. Applicants, therefore, respectfully request withdrawal of the obviousness rejection of claim 35.

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Independent claim 42 has also been rejected as obvious in view of the reference by Smith et al. Claim 42 has been amended to more clearly recite that the invention claimed includes molding a compact disc having a pattern of digital data encoded on a surface bounded by first and second pairs of spaced-apart outer side peripheries defining outer boundaries of at least portions of the disc, each of the first pair of spaced-apart outer side peripheries arcuately extending between each of the second pair of spaced-apart outer side peripheries extending substantially linearly between each of the first pair of spaced-apart outer peripheries. The disk surface containing the encoded digital data is, therefore, not a circular area within a rectangular area as described by Smith et al. Rather, in the present invention the surface containing the encoded data has four sides, two arcuate opposing sides, and two linear opposing sides. No such structure is described or suggested by Smith et al. Applicant, therefore, respectfully requests that the obviousness rejection of claim 42 be withdrawn.

#### **Conclusion**

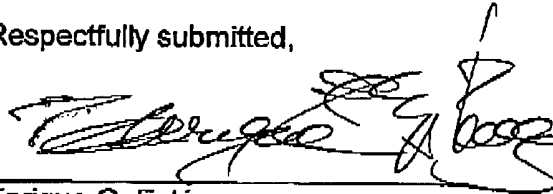
In view of the amendments and the remarks presented herein, it is submitted that these claims are patentable. In addition, their respective dependent claims, which recite yet further distinguishing features, are also patentable and require no further discussion.

If the further prosecution can be facilitated through a telephone conference between the Examiner and the undersigned, the Examiner is respectfully requested to telephone the undersigned.

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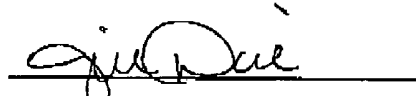
Respectfully submitted,



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